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185-3068/30070-U

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Sisk, Thomas J.  
Serial No.: 10/810,797  
Filed: 03/26/2004  
Group Art Unit: 3751  
Examiner: Nguyen, Tuan N.  
Title: INTERFACE STRUCTURE FOR SHOWER SURROUND

**APPEAL BRIEF**

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Concurrent with the filing of the Notice of Appeal, Appellant hereby submits its Appeal Brief. Appellant believes no additional fees are required in this appeal. The Commissioner is authorized to charge Deposit Account No. 50-1482 in the name of Carlson, Gaskey & Olds for any additional fees or to credit the account for any overpayment.

**I. Real Party in Interest**

Masco Corporation is the real party in interest of the present application. An Assignment of all rights in the present application to Masco Corporation was executed and recorded by the U.S. Patent and Trademark Office at Reel 016052, Frame 0118.

**II. Related Appeals and Interferences**

Appellant previously appealed the present application on June 15, 2007. In response to that appeal, the Examiner reopened prosecution in view of the Appeal Brief filed on August 15, 2007.

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In an Office Action dated October 9, 2007, the Examiner presented new grounds of rejection. Appellant now appeals these rejections.

### III. Status of the Claims

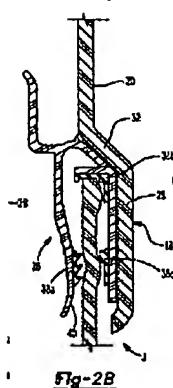
Claims 7-9 and 21-24, which are presented in the Appendix, stand finally rejected. Claims 1-6, 13-19 and 25 are cancelled. Claims 10-12 and 20 are allowed. Accordingly, the Appellant hereby appeals the final rejection of claims 7-9 and 21-24.

### IV. Status of Amendments

All amendments have been entered.

### V. Summary of Claimed Subject Matter

The present invention relates generally to a shower surround 10 (see page 2, paragraph 16). The shower surround 10 includes a first surround section comprising an inner band section 20, a second surround section comprising an outer band section 22, and a retainer assembly 36 mounted within the outer band section 22 (see page 3, paragraphs 19-20). The retainer assembly 36 includes a first frame arm 42 opposed to a second frame arm 44 and a stop 48 which extends from one of the first frame arm 42 and the second frame arm 44 (see page 4, paragraph 22). The inner band section 20 is received against the stop 48 and extends between the first frame arm 42 and the second frame arm 44 (see page 4, paragraph 22-23). This basic structure is set forth in claim 7 and is shown in Figure 2B of Appellant's application (reproduced below).

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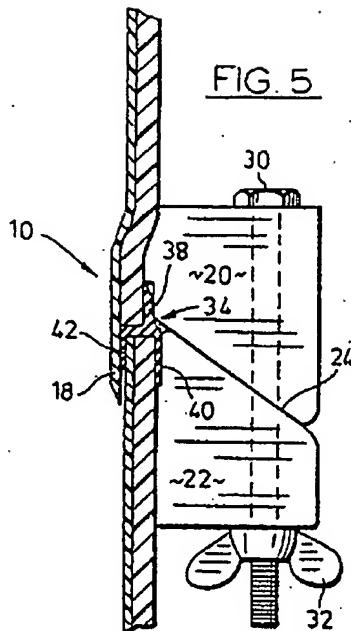
#### VI. Grounds of Rejection to be Reviewed on Appeal

- A. Are claims 7-9 and 21 properly rejected under 35 U.S.C. §102(b) as being anticipated by *Primucci* (U.S. Patent No. 4,578,832)?
- B. Are claims 22-24 properly rejected under 35 U.S.C. § 103(a) as being unpatentable as obvious over *Primucci* in view of *Dron* (U.S. Patent No. 6,677,020) or *Wissinger* (U.S. Patent No. 4,671,026)?

#### VII. ARGUMENT

- A. **The rejection of claims 7-9 and 21-24 under 35 U.S.C. §102(b) is improper.**

The Examiner finally rejected claims 7-9 and 21-24 as anticipated by *Primucci*. Appellant respectfully disagrees. *Primucci* discloses a plastic shower enclosure having a raised band 10 for adjoining an upper and lower section of a shower insert. The upper and lower sections are attached via wooden blocks 20, 22. A bolt 30 is inserted through the aligned bores of the wooden blocks 20, 22 with a wing nut 32. A gasket 34 may be utilized to seal between the upper and lower sections (See column 5, lines 7-65 and Figure 5 (reproduced below)).

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Appellant's claim 7 requires the feature of a retainer assembly. The Examiner attempts to interpret element 34 of *Primucci* as the retainer assembly, however, element 34 is actually just a gasket. Specifically, the Examiner states that the gasket 34 of *Primucci* has sufficient structure to meet the retainer assembly as claimed. As detailed above, however, *Primucci* utilizes aligned pairs of upper and lower wooden blocks 20, 22 with a bolt 30 to retain upper and lower sections as best illustrated in Figure 5 (reproduced above).

Notably, the blocks 20, 22 are chamfered to provide for retention of a shower closure but cannot properly be interpreted as having a first frame arm opposed to a second frame arm as required by claim 7. The shower enclosure of *Primucci* cannot be assembled without the upper and lower blocks 20, 22, as a gasket 34 is not designed to hold the sections together. That is, under the Examiner's interpretation, the shower enclosure could not be properly assembled. There is a difference between sealing and retaining the shower enclosure. In fact, *Primucci* specifically states

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that in most instances the gasket 34 may not even be necessary. (See column 5, lines 59-60) Accordingly, Appellant respectfully submits that claim 7 and all those claims depending therefrom are not anticipated.

#### Claim 9

Claim 9 is independently allowable over *Primucci*. Claim 9 requires that "said inner band comprises a rib which extends therefrom." The *Primucci* reference does not have an inner band including a rib extending therefrom. In contrast, the lower section illustrated in the bottom half of Figure 5 includes a uniform cross-section. A surface having a uniform cross-section cannot include a rib.

Moreover, the Examiner contends that the shelf 14 of *Primucci* represents the rib. However, the shelf 14 is not received between the arms of a retainer assembly and therefore cannot be interpreted to be the rib. The shelf 14 of *Primucci* is not even located at the raised band 10. The Examiner's interpretation of the shelf 14 is overly broad. Therefore, claim 9 is not anticipated.

#### Claim 21

Further, claim 21 is independently allowable over *Primucci*. The Examiner argues that it is inherent that a multiple of seals would be intrically mounted within the retainer assembly to receive the inner band section. This rejection also cannot be sustained. The Examiner has pointed to nothing within *Primucci* that discloses a retainer member having a multiple of seals intrically mounted therein. Specifically, the Examiner contends:

In regard to claims 21-24, since the retainer assembly is a gasket, it is inherent that a multiple of seals integrally mounted within the retainer assembly to receive the inner band. The integral seal mounted to said stop to receive an end segment of said first inner band and is generally L-shaped. The integral seal would inherently include a first surface adjacent said stop and a second surface adjacent at least one of said first frame arm and said second frame arm.

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[See Final Office Action dated January 5, 2007].

The Examiner's inherency argument essentially makes the Appellant's point. It is because *Primucci* discloses only a gasket 34, and not a retainer assembly, that the Examiner's argument fails. Put another way, it is not inherent to include a multiple of seals intrically mounted to a gasket that is also a seal. Claim 21 is not anticipated.

**B. The rejection of claims 22-24 under 35 U.S.C. §103(a) is improper.**

The Examiner finally rejected claims 22-24 as being obvious over *Primucci* in view of either *Dron* or *Wissinger*. The Examiner contends that the *Primucci* reference discloses all the features of the claims except for a seal mounted to a stop. The Examiner argues it would be obvious to one of skill in the art to mount a seal to a materially different layer to form a single assembly part as disclosed by *Dron* and *Wissinger*. Applicant respectfully disagrees with the proposed combination.

The proposed combination cannot be made because a *prima facie* case of obviousness under 35 U.S.C. §103 is not established. Whenever there is no benefit to making a proposed combination, there is no *prima facie* case of obviousness. In this instance, there would be no benefit to modifying *Primucci* with the seals of *Wissinger* or *Dron*. *Primucci* already discloses a gasket 34, which is utilized as a seal member (see column 5, lines 58-60). A person of ordinary skill in the art would not combine seal members with a gasket that is already a seal.

Again, the Examiner's argument essentially makes the Appellant's point. It is because *Primucci* discloses only a gasket 34, and not a retainer assembly, that the Examiner's argument fails. Put another way, there is no benefit to mounting a seal to a gasket that is also a seal. This overbroad approach cannot be properly supported. Claims 22-24 are not obvious.

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185-3068/30070-U**VIII. CONCLUSION**

For these reasons, the final rejection of claims 7-9 and 21-24 is improper and should be withdrawn.

Respectfully submitted,

**CARLSON, GASKEY & OLDS, P.C.**

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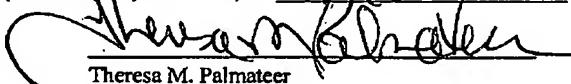
Date

  
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**CERTIFICATE OF FACSIMILE**

I hereby certify that this Appeal Brief, relative to Application Serial No. 10/810,797, is being facsimile transmitted to the Patent and Trademark Office (Fax No. (571) 273-8300) on 11-19-07.

  
Theresa M. Palmateer

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7. A shower surround comprising:
  - a first surround section comprising an inner band section;
  - a second surround section comprising an outer band section; and
  - a retainer assembly mounted to said outer band section, said retainer assembly comprising a first frame arm opposed to a second frame arm and a stop which extends from one of said first frame arm and said second frame arm, said inner band section receivable against said stop and between said first frame arm and said second frame arm.
8. The shower surround as recited in claim 7, wherein said outer band comprises a stepped band section displaced from a surround surface.
9. The shower surround as recited in claim 7, wherein said inner band comprises a rib which extends therefrom.
21. The shower surround as recited in claim 7, further comprising a multiple of seals mounted within said retainer assembly to receive said inner band.
22. The shower surround as recited in claim 7, further comprising a seal mounted to said stop to receive an end segment of said first inner band.
23. The shower surround as recited in claim 22, wherein said seal is generally L-shaped.
24. The shower surround as recited in claim 22, wherein said seal includes a first surface adjacent said stop and a second surface adjacent at least one of said first frame arm and said second frame arm.

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**EVIDENCE APPENDIX**

None.

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**RELATED PROCEEDINGS APPENDIX**

None.